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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,604	10/19/2001	James G. Clough	09166.002002	8156

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EXAMINER

MOHANDESI, JILA M

ART UNIT PAPER NUMBER

3728

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/032,604

Applicant(s)

CLOUGH ET AL.

Examiner

Jila M Mohandesi

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 3-20, 24-39 and 43-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 21-23 and 40-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 3-20, 24-39 and 43-55 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

***Drawings***

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2 and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothbart (6,092,314). Rothbart '314 discloses an orthopedic appliance, comprising a wedge (60) for placement beneath a toe (see Figure 5 embodiment), having a first upper surface disposed between a first end and an apex, a second upper surface, disposed between the apex and a second end (See Figure 9 embodiment), the first upper surface being separated from a lower planar surface by an angle of inclination between 1 and 60 degrees. See column 6, lines 66-67 and column 7, lines 1-9 and the previously attached Figure 9 embodiment.

Column 7, lines 9-19 disclose that the orthopedic appliance can also slope downwardly or taper as it extends toward the front edge (60) or toward the back edge as shown in Figure 12 embodiment. Therefore, the orthopedic appliance does incline a

Art Unit: 3728

direction substantially parallel to the medial column of the foot. If there is any doubt that the angle of inclination is between 1 and 60 degrees, Rothbart <sup>314</sup>/~~134~~ discloses that the angle of inclination of the apparatus can vary for a person with different foot structure such as sever hyperpronation and Rothbart's foot structure (see column 10, lines 33-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the angle of inclination of the orthopedic device to better comfort and fit the feet of the user.

Claims 40-42 are directed to the obvious method of using the orthopedic appliance of Rothbart <sup>314</sup>/~~134~~, which elevates a proximal phalanx to a predetermined angle of inclination using the wedge, relative to a first metatarsal, and improves stability of the foot.

4. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothbart <sup>314</sup>/~~134~~. Rothbart <sup>314</sup>/~~134~~ discloses an apparatus for orthopedic treatment, comprising a first upper surface adapted to support a proximal phalanx; a second upper surface adapted to support a distal phalanx; a bottom surface (72); and a support (60), which maintains the proximal phalanx at an angle of inclination between the first upper surface and the bottom surface, relative to a first metatarsal. See column 6, lines 66-67, column 7, lines 1-9, and column 7, lines 9-19 and previously attached Figure 10 embodiment. The angle of inclination appears to be between 1 and 60 degrees. If there is any doubt that the angle of inclination is between 1 and 60 degrees, Rothbart <sup>314</sup>/~~134~~ discloses that the angle of inclination of the apparatus can vary for a person with different foot structure such as sever hyperpronation and Rothbart's foot structure (see

column 10, lines 33-36). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the angle of inclination to better comfort and fit the feet of the user.

***Response to Arguments***

5. Applicant's arguments with respect to claims 1-2, 21-23 and 40-42 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and


Art Unit: 3728

applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the Tech Center 3700 Customer Service Center number is (703) 306-5648. For applicant's convenience, the Group Technological Center FAX number is (703) 872-9306. (Note that the Examiner cannot confirm receipt of faxes) Please identify Examiner Mohandesi of Art Unit 3728 at the top of your cover sheet of any correspondence submitted. Inquiries only concerning the merits of the examination should be directed to Jila Mohandesi whose telephone number is (703) 305-7015. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (703) 308-2672.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Donna Monroe at (703) 308-2209. Check out our web-site at "www.uspto.gov" for fees and other useful information.

**JILA M. MOHANDESI  
PRIMARY EXAMINER**



Jila M Mohandesi  
Primary Examiner  
Art Unit 3728

JMM  
October 1, 2003